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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,256	08/22/2001	Lutz Biedermann	70301/56223	2209
21874	7590	11/04/2004	EXAMINER	
EDWARDS & ANGELL, LLP			STEWART, ALVIN J	
P.O. BOX 55874			ART UNIT	
BOSTON, MA 02205			PAPER NUMBER	

3738

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,256

Applicant(s)

BIEDERMANN ET AL 

Examiner

Alvin J Stewart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16, 23 and 24 is/are allowed.
- 6) ☒ Claim(s) 9-11, 13-15 and 17-22 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-11, 14, 15, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 29820904U1.

DE 29820904U1 discloses a first spring extending from a toe region to a lower leg region, a second spring element extending from a heel region to a lower leg region, a tension element connected to a forward region of the first element and to a heel region of the second element, wherein the tension element is structured and arranged to be able to transmit only a tension force (see attachment in Fig. 5).

Claims 9-11, 15, and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Pitkin US Patent 5,376,139

Pitkin discloses a first spring extending from a toe region to a lower leg region, a second spring element extending from a heel region to a lower leg region, a tension element connected to a forward region of the first element and to a heel region of the second element, wherein the tension element is structured and arranged to be able to transmit only a tension force (see attachment Fig. 2).

Claim Rejection - 35 U.S.C. 112, First Paragraph

The following is a quotation of the first paragraph of **35 U.S.C. 112**:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9, 13-15, and 17-22 are rejected under **35 U.S.C. 112**, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 9, line 9 discloses a tension element capable of transmitting only a tension force between its one end and its other end. The Examiner has not been able to find a paragraph, line or phrase that discloses a tension element capable of transmitting only a tension force. The Applicant is required to show in the specification the limitation claimed in claim 9, line 9. If the Applicant is not able to show in the specification the above limitation, the Applicant has to withdraw the claimed limitations. Correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 9, 13-15, 17, 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Doddroe et al US Patent 6,602,295 B1.

Doddroe et al (see Fig. 2) discloses a prosthetic foot (10A) comprising a first spring element (40) extending from a toe region (see marks by the Examiner) to a lower leg region

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(130), a second spring element (150) extending from a heel region (see marks by the Examiner) to the lower leg region (130). The springs are connected to each other by an adapter (132) at the upper portion of the prosthetic foot and by a tension element (20). The tension element (20) has two ends, the first end is connected by the heel region and the second end is connected by the toe region (see marks made by the Examiner in Fig. 2). The tension element is a ribbon-like element and is capable of transmitting a tension force between the ends. Finally, the first and the second spring elements are each a leaf spring having a ground-side surface and the elements are arranged and structure to rest and face each other (see Examiner's marks).

Regarding claim 9, the tension element of the Doddroe et al reference is capable to transmit a tension force between its one end and its other end.

Regarding claim 14, the Examiner has interpreted the ribbon-like structure as a strip similar as the strip of fabric. The claims disclosed above are given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974).

Response to Arguments

Applicant's arguments filed July 08, 2004 have been fully considered but they are not persuasive.

The Examiner has maintained the Doddroe reference and the 112, 1 st paragraph rejections. The Applicants' arguments have not been enough to overcome the rejections. The Applicants' representative has not given enough proof to show that the ribbon-like element cannot transmit a compression force and can transmit only a tension force.

Regarding the declaration filed on July 08, 2004, The declaration under 37 CFR 1.132 filed July 08, 2004 is insufficient to overcome the rejection of claims 9, 13-15 and 17-22 based

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upon insufficiency of disclosure under 35 U.S.C. 112, first paragraph as set forth in the last Office action because: the Applicants' have only shown a declaration of Mr. Biedermann disclosing that the term "ribbon-like" element inherently means that there is no compressive strength and a dictionary meaning of the words "rope" and "ribbon" which are available on the internet. Additionally, the Applicants submit that is well known in the art that a ribbon has a structure that, like a rope, has tensile strength but is incapable of transmitting a compressive force. However, the Applicants have not been able to find support in record or in a publication or the like describing a "*ribbon-like*" element as having only tensile strength. The Applicants have shown the meaning of the word "ribbon", however, have not shown the meaning of the word "ribbon-like". The word "ribbon-like" make the structure element broader than the word "ribbon". In order to interpret the claims as broad as possible you have to find a structure that is capable of being similar to a ribbon (e.g. same shape, etc.).

Allowable Subject Matter

Claims 16, 23 and 24 are allowed.

Claims 12, 21, and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J Stewart whose telephone number is 703-305-0277. The examiner can normally be reached on Monday-Friday 7:00AM-5:30PM(1 Friday B-week off).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. Stewart

Alvin J Stewart
Primary Examiner
Art Unit 3738

October 30, 2004.